



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,539	12/26/2001	Rolf Biedermann	112740-328	2056

29177 7590 03/29/2004

BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER

MILLER, BRANDON J

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 03/29/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,539

Applicant(s)

BIEDERMANN, ROLF

Examiner

Brandon J Miller

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2683

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nara in view of Naddell.

Regarding claim 10 Nara teaches a mobile communications terminal which can be activated at one of a plurality of different base stations to set up and conduct communication connections with a telecommunications network via a respective base station (see col. 2, lines 50-58 and col. 3, lines 1-9). Nara teaches a mobile terminal including a numbers memory (see col. 4, lines 13-17); a display for displaying names assigned to call numbers stored in the numbers memory (see col. 4, lines 18-20 & 23-25); and a part for transferring a call number to a base station in response to a selection by a user of a displayed name assigned to a call number (see col. 5, lines 20-33 & 38-46). Nara teaches storing in local information sent to the mobile terminal, information that indicates with which of the plurality of base stations a call number can be dialed (see col. 3, lines 14-16 and col. 5, lines 27-33 & 38-46). Nara does not specifically teach a telecommunications terminal wherein it is possible to store in the numbers memory, information that indicates with which of the plurality of base stations a call number can be dialed. Naddell teaches a telecommunications terminal wherein it is possible to store in memory, information that indicates with which of a plurality base stations communications can be made

Art Unit: 2683

(see col. 3, lines 1-13, 20-22 & 25-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a telecommunications terminal wherein it is possible to store in the numbers memory, information that indicates with which of the plurality of base stations a call number can be dialed because this would allow for a telecommunications terminal that can efficiently obtain local information associated with a local area where it is located and perform a function based on that information.

Regarding claim 11 Nara teaches a display only displaying names among the names assigned to the stored call numbers which can be dialed with a designated base station (see col. 5, lines 20-33 & 38-42).

Regarding claim 12 Nara teaches a mobile telecommunications terminal wherein the numbers memory has a plurality of columns, including a numbers column containing stored call numbers (see col. 4, lines 21-25 and FIG. 3). Naddell teaches a stations column specifying the base stations with which communications can be made (see col. 3, lines 1-13 & 25-29 and FIG. 2).

Regarding claim 13 Nara teaches a numbers memory that includes a plurality of columns which are respectively assigned to a base station, such that the call numbers which can be dialed with the respective base station are respectively stored in each column (see col. 5, lines 20-33 & 38-42 and FIG. 3).

Regarding claim 14 Nara teaches an operator control element for the user to designate a base station (see col. 3, lines 14-16 and col. 5, lines 2-6).

Art Unit: 2683

Regarding claim 15 Nara teaches a terminal that is set up to establish an identity of the base station at which the terminal is activated and to make the base station a designated base station (see col. 3, lines 14-16, col. 4, lines 55-58, and col. 5, lines 1-6).

Regarding claim 16 Nara and Naddell teach a device as recited in claim 10 except for an operator control element for switching the display between a dialing operating state, in which only the names which can be dialed with the designated base station are displayed, and an editing operating state, in which all data stored in the numbers memory is displayed. Nara does teach a display, in which only the names that can be dialed with the designated base station are displayed (see col. 5, lines 20-33 & 38-42). Nara does teach editing data stored in the numbers memory and displaying all data stored in the numbers memory (see col. 4, lines 13-16 & 19-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include operator control element for switching the display between a dialing operating state, in which only the names which can be dialed with the designated base station are displayed, and an editing operating state, in which all data stored in the numbers memory is displayed because this would allow for a mobile terminal to efficiently obtain information related to a local calling area.

Regarding claim 17 Nara and Naddell teach a device as recited in claim 10 except unless otherwise specified by the user, the terminal stores with respect to a call number entered by the user into the numbers memory information that the number can be dialed with all of the base stations. Nara does teach storing with respect to a call number entered by the user into the numbers memory information that the number can be dialed with any base station in a local area (see col. 4, lines 21-28). It would have been obvious to one of ordinary skill in the art at the time

Art Unit: 2683

the invention was made to make the invention adapt to include unless otherwise specified by the user, the terminal stores with respect to a call number entered by the user into the numbers memory information that the number can be dialed with all of the base stations because this would allow for improved utilization of available communication services.

Regarding claim 18 Nara teaches a mobile telecommunications terminal that is a cordless telephone (see col. 2, lines 52-53).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marsolais WO 98/27778 discloses a method and system for displaying greetings in a mobile radio communications system.

Negishi EP 0 777 399 discloses a portable telephone with current location display and network thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J Miller whose telephone number is 703-305-4222. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2683

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 17, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600